

ARGUMENT

The Examiner objected to the disclosure, arguing that claim 6, paragraph (c) (ii) contained an informality. Specifically, the Examiner requested correction of “element” to “elements”. Further, the Examiner:

- a) objected to claim 11 under 37 CFR § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim; and
- b) rejected claims 6-11 under 35 U.S.C. § 103(a) as being unpatentable over Sauer et al. (5,441,041) and Goodwin et al., (5,817,061), each in view of the other.

With regard to the objection made by the Examiner, the Applicant has amended claim 6 and cancelled claim 11, as per the Examiner’s recommendations. As for the rejection of claims 6-11 under 35 U.S.C. § 103(a), the Applicant respectfully offers the following.

Three criteria must be established in order to make out a *prima facie* case of obviousness based on a combination of prior art references. First, there must be some suggestion or motivation, either in the references used by the Examiner or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references, when combined, must teach or suggest all of the claimed limitations. *See M.P.E.P. § 2143; see also In re Vaeck,*

947 F.2d 488, 493 (Fed. Cir. 1991). The teaching or suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. *Vaeck*, 947 F.2d. at 493.

The ultimate determination of whether an invention would have been obvious under 35 U.S.C. § 103(a) is a legal conclusion based on underlying findings of fact. *See In re Dembicza*k, 175 F.3d at 998, 50 USPQ2d at 1616 (Fed.Cir.1999). Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence. *See id.* at 1312, 203 F.3d 1305, 53 USPQ2d at 1773 (quoting *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229-30, 59 S.Ct. 206, 83 L.Ed. 126 (1938)). In reviewing the record for substantial evidence, the Board must take into account evidence that both justifies and detracts from the factual determinations. *See Universal Camera Corp. v. NLRB*, 340 U.S. 474, 487-88, 71 S.Ct. 456, 95 L.Ed. 456 (1951).

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See Dembicza*k, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir.1983).

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir.1998). Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.Cir.1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed.Cir.1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed.Cir.1996).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See *WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed.Cir.1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (1981) (and cases cited therein). Whether the Board relies on an express or an implicit showing, it must provide particular findings related

thereto. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." *Id.*

As stated above, the Examiner has rejected claims 6-11 as being unpatentable under 35 USC § 103(a) over Sauer et al. and Goodwin et al., each in view of the other.

The Examiner first argues that the Sauer et al. reference is obvious in view of the Goodwin et al. reference. In making this argument, the Examiner states that "the Sauer et al. disclosure is silent as to whether the blade head is blunt or sharp". However, a careful review of the Sauer et al. reference indicates that the blade head is intended to be sharp and designed to cut tissue. To support this assertion, the Examiner's attention is respectfully drawn to Figures 1-5A of the Sauer et al. disclosure. Applicant respectfully argues that each figure illustrates a blade having a sharp, single tip designed for cutting, as opposed to a blunt tip. Further, the specification and claims of the Sauer et al. reference continually refer to the blade as a "cutting blade". See column 2, line 57, 60, and 63; column 3, lines 9, 54, 58 and 61; column 6, lines 13, 17, 19, 21 and 51; and column 7, lines 7, 11, 13, 14 and 35.

As further evidence of the nature of the "cutting blade" of the Sauer et al. reference, the Applicant respectfully submits that the term "blunt" or "bluntly" is utilized by the Sauer et al. reference only when referring to use of the trocar when the obturator blade is in a retracted position, i.e. not in use. Please see column 5, lines 37-41. In short, Applicant respectfully argues that, the language of the Sauer et al. reference clearly denotes the use of a sharp blade for the purpose of cutting.

The Examiner argues that it would have been obvious for one of ordinary skill in the art to make the blade edges of Sauer et al. blunt so as to have the “self evident advantage of preventing inadvertent cutting of tissue while still permitting the dissection of tissue when desired”. The Examiner continues by stating that “with this modification, the head of the Sauer et al. blade (at the tip) would be blunt as claimed”.

Applicant respectfully argues that the modification of the Sauer et al. reference proposed by the Examiner would change the principal of operation of the Sauer et al. device. In short, the Examiner has proposed that one of ordinary skill in the art would be motivated to completely replace the sharp cutting blade of the Sauer et al. reference with a blunt, non-cutting blade. Applicant respectfully argues that the proposed modification would require substantial reconstruction and redesign of the Sauer et al. blade, as well as the basic principal under which the Sauer et al. reference was designed to operate, i.e. utilization the cutting blade to cut tissue.

If the proposed modification or combination of the prior art would change the principal of the operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facia* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in

'the basic principal under which the [primary reference] construction was designed to operate.' 270 F.2d at 813, 123 USPQ at 352.).

In light of the above arguments and relevant legal authority, Applicant respectfully argues that the Examiner's rejection under § 103 cannot stand and must be withdrawn.

Alternatively, the Examiner argued that claims 6-11 are obvious in light of Goodwin et al. in view of Sauer et al. Specifically, the Examiner argues that the Goodwin et al. reference "discloses blunt edged blades 18 but fails (sic) to disclose that they meet to form a single 'blade'." The Examiner continues by stating that "Sauer et al. teaches (sic) that blade edges (at 34) on a conical obturator should extent (sic) to the tip (or head) of the obturator and meet and those form a blade apparently in order to dissect tissue effectively". To support this statement, the Examiner cites to column 5, lines 19-24 of the Sauer et al. reference which reads:

Pressure is applied to hand grip 21 in the distal direction to penetrate the body tissue. The movement of blade 34 facilitates cutting of the body tissue, thus permitting the surgeon to apply minimal pressure to hand grip 21 to penetrate the body tissue.

As can be seen from a review of the text above, this portion of the Sauer et al. reference does not teach or suggest that blade edges should be extended to meet at the tip. In contrast, this portion of the Sauer et al. reference describes movement of the entire cutting blade, as a whole, for the purpose of cutting body tissue. Applicant respectfully argues that neither the Sauer et al. reference nor the Goodwin et al. reference teaches or suggests the modification proposed by the Examiner. As

such, the Examiner's rejection under § 103 should be withdrawn as there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time the invention was made to modify the reference or combined teachings.

REMARKS

Applicant amended the claims and specification to clarify the structure which applicant believes distinguishes the invention over the cited references, to clarify the functions of the claimed invention, and to clarify the limitations within the claims drawn to such structure. However, amendments have not been made to narrow the claims of the original application but, rather simple, to clarify claims due to grammar that the Examiner found unclear.

Applicant respectfully requests that this amendment/response be considered by the Examiner and a notice of allowance be entered.

If the Examiner feels that a telephone conference with the undersigned would be helpful to the examination and allowance of this application, a telephone conference is respectfully requested.

Respectfully submitted,
JACKSON WALKER L.L.P.



Richard R. Ruble, Reg. No. 45,720
112 E. Pecan Street, Suite 2100
San Antonio, Texas 78205
Phone: 713/752-4200
Fax: 713/752-4221
Attorneys for Applicant

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service, with sufficient postage as First Class Mail (37 CFR 1.8(a)), in an envelope addressed to Mail Stop Response, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

January 14, 2004
Date

Bea Baldwin
Bea Baldwin